

REMARKS

I. Introduction

Claims 1-146 are pending in the above-identified application. Claims 1-18, 38-54, 73-90 and 110-127 were provisionally elected during a telephone conversation between the Examiner and Applicants' attorney James Leiz. Applicants hereby confirm the provisional election. Therefore, claims 19-37, 55-72, 91-109, and 128-146 are currently withdrawn. Claims 9-11, 13, 15-18, 39-54, 73-90, and 110-127 are original. Claims 1, 3-8, 14, and 38 are currently amended. Claim 2 is canceled. No new matter is added.

Claim 38 is objected to because of informalities. Claims 38-54 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-18 stand rejected under 35 U.S.C. § 101 as not being a patent eligible process. Claims 1-3, 7-9, 14-17, 38, 39, 43-45, 50-53, 73-75, 79-81, 86-89, 110-112, 116-118 and 123-126 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,618,746 to Desai et al. (hereinafter, "Desai"). Claims 4-6, 40-42, 76-78 and 113-115 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai. Claims 10, 11, 46, 47, 82, 83, 119 and 120 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over Desai in view of U.S. Patent No. 6,895,405 to Choi et al. (hereinafter, "Choi"). Claims 12, 18, 48, 54, 84, 90, 121 and 127 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,993,495 to Smith et al. (hereinafter, "Smith"). Claims 13, 49, 85 and 122 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of Choi and further in view of Smith.

Applicants respectfully traverse the Examiner's objections and rejections.

II. Response to the Objection to Claim 38

The Examiner objected to the misspelling of the word "configures." Applicants have amended claim 38 to correct the misspelling. Accordingly, Applicants respectfully request reconsideration of the objection to claim 38.

III. Response to the Rejection of Claims 38-54 Under § 112

The Examiner rejected claims 38-54 as being indefinite because it was unclear what is specifically encompassed by software and hardware. Applicants have amended claim 38 to replace "software and hardware" with "a processor," thereby obviating the rejection of the claim. Claims 39-54 depend from independent claim 38 and include all the limitations of claim 38. Accordingly, Applicants respectfully request reconsideration of the rejection of claims 38-54 under § 112.

IV. Response to Rejection of Claims 1-18 Under § 101

Amended pending claims 1-18 are drawn to statutory subject matter. "A method claim recites statutory subject matter only if it is embodied in, operates on, transforms, or otherwise involves another class of statutory subject matter, i.e. a machine, manufacture, or a composition of matter." *Ex parte Wasynzuk*, Appeal 2008-1496, June 2, 2008. Method claims 1-18 recite, among other things, using a first computing device and a second computing device, and thus are proper subject matter because they involve another class of statutory subject matter, namely machines. The amended claims are grounded in structure and do not cover the use of disclosed concepts divorced from the recited structure (i.e., the claims do not prohibit manual calculation). Therefore, Applicants submit that the claims set forth patentable subject matter under §101. For at least the foregoing reasons, Applicants request reconsideration and withdrawal of the §101 rejections of amended independent claims 1-18.

V. Response to the Rejections of Claims 1-18, 38-54, 73-90 and 110-127

Claims 1-3, 7-9, 14-17, 38, 39, 43-45, 50-53, 73-75, 79-81, 86-89, 110-112, 116-118 and 123-126 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,618,746 to Desai. As stated in the MPEP §2131, "A claim is

anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Generally, amended independent claim 1 is directed to a method for selecting survey questions for inclusion in a survey. The method includes storing survey questions and survey response information provided by survey participants and determining an inclusion value for each survey question. The method includes selecting a stored survey question for inclusion in a survey based on the inclusion value of each survey question and providing the selected survey question to a survey participant. As recited in original claims 15 and 16, the survey question may be selected because the inclusion value for the selected question is higher than the inclusion value of other stored survey questions, or the inclusion value for the selected question is higher than a designated threshold inclusion value.

Desai fails to disclose an inclusion value. Desai further fails to disclose steps for determining an inclusion value and selecting questions based on the inclusion value. The Office Action states that Desai teaches this limitation and that the "inclusion value is the determination, yes or no, inherent

to the 'branching' or 'piping' logic of Desai." Applicants respectfully disagree. Although Applicants disclose that the inclusion value may be based on associated conditional branching logic, the inclusion value itself is not inherent in conditional branching. Conditional branching, as described in Desai, is merely a user-driven selection whereby based on a user response of "yes" or "no" a question in a survey is presented to the user. These yes/no responses are simply user responses and not inclusion values. If the user selects "yes", then the user is presented with a specific predetermined question; if the user selects "no", then the user is presented with another specific predetermined question. There is no determination of an inclusion value for a question.

There is also nothing in Desai for selecting a question based on the inclusion value, either by comparing to another inclusion value of another question or a threshold value. The Office Action argues that in Desai, "the inclusion value of the selected question is '1' [and] the inclusion value of the other unselected question is '0'." This is not disclosed anywhere in Desai. Moreover, Desai's conditional branching does not require assigning "ones" and "zeros" to user-responses. For example, Desai's conditional branching can be implemented using if-then statements, without assigning any inclusion values to questions.

Thus, Desai does not disclose all the elements of amended independent claim 1 and original dependent claims 15 and 16 as is required by MPEP §2131 to make a proper rejection under §102. Therefore, Applicants request reconsideration and withdrawal of the 35 U.S.C. §102 rejections of independent claim 1 and dependent claims 15 and 16. Claims 3, 7-9, 14, and 17 depend from claim 1 and add further limitations thereto. Therefore, Applicants request reconsideration and withdrawal of the 35 U.S.C. §102(e) rejections of these claims, as well.

Independent claims 38, 73 and 110 include similar subject matter. Applicants respectfully requests reconsideration and withdrawal of the § 102 rejections of independent claims 38, 73 and 110. Claims 39, 43-45, 50-53, 74-75, 79-81, 86-89, 111-112, 116-118 and 123-126 depend from claims 38, 73 or 110 and add further limitations thereto. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well.

Claims 4-6, 40-42, 76-78 and 113-115 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai. Claims 10, 11, 46, 47, 82, 83, 119 and 120 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of U.S. Patent No. 6,895,405 to Choi. Claims 12, 18, 48, 54, 84, 90, 121 and 127 stand rejected under 35 U.S.C. § 103(a) as being

unpatentable over Desai in view of U.S. Patent No. 6,993,495 to Smith. Claims 13, 49, 85 and 122 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Desai in view of Choi and further in view of Smith. "To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Even combining the teachings of Desai, Smith, and Choi there is no teaching or suggestion for determining inclusion values for each survey question. Since neither Desai nor Smith nor Choi teach or suggest each and every element of independent claims 1, 38, 73 and 110, Applicants respectfully submit that the cited references do not render obvious Applicants' independent claims 1, 38, 73 and 110. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Claims 4-6, 10-13, and 18 depend from claim 1 and add further limitations thereto. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well. Claims 40-42, 46-49, 54, 76-78, 82-85, 90, 112-115, 119-121, and 127 depend from claims 38, 73 and 110, respectively, and add further limitations thereto. Thus, Applicants request reconsideration and withdrawal of the rejections of these claims, as well.

VI. Conclusion

In view of the foregoing, the claims are in condition for allowance. This application is therefore in condition for allowance. Reconsideration and allowance of the application are respectfully requested.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 06-1075, under Order No. 002278-0004 from which the undersigned is authorized to draw.

Respectfully submitted,

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